

Application Serial No. 10/538,426  
Reply to Office Action of July 9, 2008

PATENT  
Docket: CU-4247

### REMARKS

In the Office Action, dated July 9, 2008, the Examiner states that Claims 1-13 are pending and rejected. By the present Amendment, Applicant amends the claims.

#### 1. Rejections under 35 U.S.C. 103(a)

Claims 1, 3-8 and 10-13 are rejected under 35 U.S.C. 103(a) as unpatentable over Carrick (U.S. Pub. 2004/012335) in view of Katafuchi (U.S. 6,159,911) for the reasons of record. Claims 1-2, 4-8 and 10-13 are rejected under 35 U.S.C. 103(a) as unpatentable over Carrick in view of Chambard (U.S. Pub. No. 2002/0082176). Claims 1-3, 5-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carrick in view of Tamoto (U.S. 5,458,807). Applicant respectfully disagrees with and traverses these rejection.

Applicant indicates that the rejected claims have been amended to further specify the alkyl substituents ( $R^1$  and  $R^2$ ) of the salicylates. As amended, the salicylates are not described in Katafuchi, Carrick, Chambard, or Tamoto. As such, Applicant respectfully asserts that even if the cited prior art was combined as suggested by the Examiner, it would fail to teach each and every feature of the rejected claims.

Moreover, Applicant hereby submits experimental data to evaluate whether the dioctylsalicylic acid described in Katafuchi is working as component of the lubricating oil additive (corresponding to the component (A)) or not.

After Ca 3,5-dioctylsalicylate was synthesized,  $\text{Ca}(\text{OH})_2$  and alcohol were added thereto and  $\text{CO}_2$  was blown into the solution to make it (per) basic salt.

However, the carbonization reaction of Ca 3,5-dioctylsalicylate was not successfully attained because of poor oil solubility of the reaction product. So the expected additive component can not be obtained. Then it is found that (per) basic salt of 3,5-dioctylsalicylate has poor oil solubility because of the shortage of alkyl chain length, and can not work as a component of lubricating oil additive.

In addition, by comprising the component (A), the lubricating oil additive of the present invention includes a vastly superior storage stability than those, if any, of the prior art.

Katafuchi discloses that dodecylmethylsalicylic acid is an example of the alkylsalicylic acids but this can not be produced by the production method described in Katafuchi. Dodecylmethylsalicylic acid can not be synthesized by alkylation of

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phenol, but by alkylation of cresol. So this dodecylmethysalicylic acid is not practically available in Katafuchi. As such, Applicant asserts that Katafuchi does not enable what it discloses.

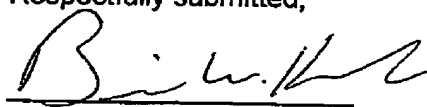
In view of the foregoing, Applicant respectfully requests withdrawal of the outstanding rejections under 35 U.S.C. 103(a).

Accordingly, all the outstanding objections and rejections are considered overcome. Applicant respectfully submits that this application should now be in condition for allowance and respectfully requests favorable consideration.

Respectfully submitted,

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Date



Attorney for Applicant  
Brian W. Hameder  
c/o Ladas & Parry LLP  
224 South Michigan Avenue  
Chicago, Illinois 60604  
(312) 427-1300  
Reg. No. 45613